



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Pearson et al.

Serial No.: 10/772,121

Group Art Unit: 1714

Filed: February 4, 2004

Examiner: P. Szekely

For: POLYMER BLENDS

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL REQUEST FOR REVIEW

Applicants request review of the final Office Action mailed on July 3, 2007. No amendments are being filed with this Request. The Request is being filed with a Notice of Appeal.

In the final Office Action, claims 1, 3-33, and 68-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono (US 6,727,303) or Hashimoto (US 6,780,917) in view of Pfaendner (US 5,859,073) or Hudson (US 6,077,890), in view of Jackson (US 4,287,325), Morris (US 4,525,504), Light (US 4,578,437), Funasaki (US 4,956,407), Carico (US 4,972,015), Golder (US 5,032,631), Dickerson (US 5,656,715), Minnick (US 5,919,848), Webster (US 5,965,261), Cornell (US 6,054,551), Cobb (US 6,100,320), Jones (US 6,103,857), Aylward (US 6,187,523), Keep (US 6,277,905 B1), Panandiker (US 6,284,845), Opalko (US 6,469,083), Moskala (US 6,551,688), Jeon (US 6,342,579), Agniel (US 2002/0045022), or Pierre (US 2003/0045022).

The rejection lacks one or more essential elements needed for a *prima facie* case of obviousness.

For rejections under 35 U.S.C. § 103(a), it is the Office's policy to follow *Graham v. John Deere Co.* and to perform the four factual inquiries enunciated in that decision. *MPEP* § 2141 at 2100-116. The four factual inquiries are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims at issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The rejection in this case, however, falls far short of complying with the law and the Office's policy. For example, the rejection fails to set forth the difference or differences between the cited references and the rejected claims. *MPEP* § 2141.02. The rejection fails to show how the cited references when combined teach or suggest all of the recitals of the rejected claims. *MPEP* § 2142 at 2100-125. And the rejection fails to evaluate the evidence of unexpected results discussed in Applicants' *Second Reply and Amendment* at 28-29 (Dec. 12, 2006).

In response to the above arguments, the Examiner states that "[i]n the last three actions the examiner has pointed out what the cited references contain and where they contain the subject matter." *Final Office Action* at 2 (July 3, 2007). However, the Examiner's burden of establishing a *prima facie* case of obviousness requires much more than that. It requires inquiry into all four of the factors enumerated above.

In this case, at best, the Examiner has embarked upon the first step of a multi-step process, and the Examiner is attempting to improperly shift the burden onto Applicants to do the rest. *See id.* ("Applicants have chosen not to point out what the deficiencies of the individual references are and what each reference lacks.").

Because the Examiner has omitted one or more essential elements needed for a *prima facie* case of obviousness, and the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Respectfully submitted,

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Oct. 2, 2007

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CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Mary Harrison
Mary Harrison

October 2, 2007
Date